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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/497,383
Filing Date: February 03, 2000
Appellant(s): BAHR ET AL.

Jon Jurgovan, Reg. No. 34,633
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 April 2006 appealing from the Office action mailed 17 November 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

I. Whether Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 are patentable over "Quillix Data Sheet" alleged to be prior art;

II. Weather Claims 2, 23, and 63 are Nonobvious under 35 U.S.C. 103(a) over the "Quillix Data Sheet alleged to be prior art.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Prevalent Software, Inc. "Quillix Data Sheet", 2 pages.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 are rejected as being anticipated by Applicant's admitted prior art, specifically "Quillix Data Sheet" ("Quillix").

In the response filed 7 May 2004, the Applicant entered Exhibit 21 on pages 60-62 of the response, which was a press release entitled "Prevalent Software, Inc. Introduces Quillix" which was released and revealed to the public on 18 January 2000 at the Optika International Summit before the effective filing date of 3 February 2000 of the instant application. The

Applicant stated on page 62 that "...Quillix appears to contain similar or the same functionality as the claimed invention." A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). A rejection based on the Quillix invention is shown below.

Regarding claim 1, "Quillix" discloses a method comprising the step of a) generating a display based on a hypertext mark-up language (HTML) document stored in a client device using a web browser of a user interface of the client device (see figure on page 1), the display including a document display portion (see image of 'Purchase Order' in figure), an index field portion (see 'Batch name' in figure), and a control portion (see '-Rotate', 'Rotate+', etc. in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...") all visibly defined in the display in separate portions thereof by the HTML document, the document display portion including a display of document data received from a scanner coupled to the client device, the scanner generating the

document data by scanning a document in print form , the document data representing the scanned document (page 1, "Quillix acquires user input via...TWAIN input devices such as desktop scanners..."), the index field portion permitting index data to be input by a user with an input device of the client device into the user interface in association with the document data (see 'Batch name' in figure; page 1, "Information can be entered into a Quillix form can be used to create an independent data record or be associated with a scanned image for indexing purposes"), and the control portion including at least one control element operable by the user with the input device for generating a start scan signal to initiate scanning of the document with the scanner to generate the document data (see 'Start Scanning' in figure) and for generating a send data signal to transmit the document data with the index data displayed by the web browser from the client device to the server over a network using a destination address for the server specified in an address field of the web browser (see 'Release batch' in figure; page 2, "Release", "The Quillix Web Client releases image batches to the server for final processing").

Regarding claim 3, "Quillix" discloses a method as claimed in claim 1, wherein the control portion includes at least one control element that can be activated by the user with the input

device to adjust the scale of the display of the document data. (see 'Zoom+' and 'Zoom-' in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 4, "Quillix" discloses a method as claimed in claim 3, wherein the control element can be activated by the user with the input device to increase the scale of the display of the document data ("zoom in"). (see 'Zoom+' in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 5, "Quillix" discloses a method as claimed in claim 3, wherein the control element can be activated by the user with the input device to decrease the scale of the display of the document data ("zoom out"). (see 'Zoom-" in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 6, "Quillix" discloses a method as claimed in claim 3, wherein the control element can be activated by the user with the input device to scale the document data to fit within the document display portion of the display. (see 'FitHeight' in Figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 7, "Quillix" discloses a method as claimed in claim 3, wherein the control element can be activated by the user with the input device to scale the document data for display in the document display portion to the same scale as the scanned document. (see 'FitWidth' in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 8, "Quillix" discloses a method as claimed in claim 3, wherein the control portion includes a control element activated by the user with the input device to select document data from among a plurality of scanned documents for display on the document display portion of the display. (See '<<', '<', '>', and '>>' in figure; page 2, "Review tools allow users to view an image batch...")

Regarding claim 9, "Quillix" discloses a method comprising the steps of: a) generating at a client device a start scan signal using a control element defined by a hypertext mark-up language (HTML) document stored in the client device and displayed by a web browser of a user interface of the client device in response to a user's operation of an input device of the client device (see 'Start Scanning' in figure);

b) at the client device, converting the start scan signal into a form compatible with a scanner; c) at the client device,

transmitting the converted start scan signal from the client device to the scanner; d) receiving the converted start scan signal at the scanner; and e) scanning a document with the scanner to generate document data, in response to the converted start scan signal received in said step (d). (page 2, "Capture begins with the acquisition of images via the Quillix TWAIN interface, which accepts input from low or high-volume scanners")

Regarding claim 10, "Quillix" discloses a method as claimed in claim 9, wherein said step (a) is performed by depressing and releasing a control element of the user interface of the client device using a mouse constituting at least part of the input device. (page 1, "The web client includes a lightweight image viewer and modules for data or image capture, review, indexing, and release of information...Since Quillix runs within a web browser, using Quillix is as easy as surfing the Internet")

Regarding claim 11, "Quillix" discloses a method as claimed in claim 9, further comprising the steps of: f) transmitting the document data from the scanner to the client device; g) receiving the document data at the client device; h) at the client device, converting the document data into a form that can be displayed within the web browser of the client device; and i) generating a display including the scanned document on the web

browser of the client device, based on the document data converted in step (h). (page 2, "Capture begins with the acquisition of images via the Quillix TWAIN interface, which accepts input from low or high-volume scanners")

Regarding claim 12, "Quillix" discloses a method as claimed in claim 11, further comprising the step of: j) adjusting the display of the document data via a user's operation of a control element defined by the HTML document displayed by the web browser within the user interface. (see '-Rotate', 'Rotate+', etc. in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 13, "Quillix" discloses a method as claimed in claim 12, wherein the adjusting of said step (j) includes increasing the scale of the display of the scanned document ("zooming in") on the user interface. (see 'Zoom+' in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 14, "Quillix" discloses a method as claimed in claim 12, wherein the adjusting of said step (j) includes decreasing the scale of the display of the scanned document ("zooming out") on the user interface. (see 'Zoom-" in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 15, "Quillix" discloses a method as claimed in claim 12, wherein the adjusting of said step (j) includes scaling the display of the scanned document to fit within the document display portion of the display of the user interface of the client device. (see 'FitHeight' in Figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 16, "Quillix" discloses a method as claimed in claim 12, wherein the adjusting of said step (j) includes generating the display of the scanned document on the user interface of the client device with the same scale as the scanned document. (see 'FitWidth' in figure; page 2, "Review tools allow users to...make adjustments using automated image processing...")

Regarding claim 18, "Quillix" discloses a method as claimed in claim 12, further comprising the step of:

k) generating a multiscan mode signal via a user's operation of a control element defined within the web browser at the user interface of the client device, said steps (e)-(g) repeatedly performed to generate document data for a plurality of documents, based on the multimode scan signal. (see 'Start Scanning' and 'page 1 of 7' in figure; see also 'batch' as defined in the document; page 1, "Quillix forms are accessed and

defined within the context of a Batch Profile." and page 2, "Capture begins with the acquisition of images via the TWAIN interface, which accepts input from low or high-volume scanners" and "Configurable batch profiles define how a batch is captured...")

Regarding claim 19, "Quillix" discloses a method as claimed in claim 18, further comprising the steps of

1) generating a selection signal via a user's operation of a control element defined within the web browser of the client device indicating at least one of the first, last, next and previous scanned documents for display; and m) displaying the document data for one of the scanned documents within the web browser of the client device, based on the selection signal generated in said step (l). (See '<<', '<', '>', and '>>' in figure; page 2, "Review tools allow users to view an image batch...")

Regarding claim 20, "Quillix" discloses a method as claimed in claim 12, further comprising the steps of: k) user inputting predetermined index data into an index field defined by the HTML document separately from a document display portion in which the document data from the scanner is displayed by the web browser of the user interface of the client device; (see 'Batch Name' in figure; page 2, "Quillix includes a tool for the creating of new

indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

l) generating a send data signal using the control element operated by a user with the input device and defined by the HTML document displayed by the web browser of the user interface of the client device; m) transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal generated in said step (l); n) receiving the document data and index data at the server; and o) storing the document data in association with the index data in a database of a data storage unit separate from the server. (see 'release batch' in figure; page 1, "Information entered into Quillix is processed by the Quillix server and then sent to the corporate system for further dispensation" and page 2, "The Quillix Web Client releases image batches to the server for final processing" and "Once released, the batched data is sent to the corporate information management system")

Regarding claim 21, "Quillix" discloses a method as claimed in claim 20, wherein the index data includes predetermined identification data to identify the document. (see 'Batch Name" in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 22, "Quillix" discloses a method as claimed in claim 20, wherein the document data and the index data are transmitted between the server and client device in hypertext transfer protocol (HTTP). (page 1, "Quillix is the first distributed information capture system built for the Internet")

Regarding claim 24, "Quillix" discloses a method as claimed in claim 20, wherein the start scan signal is input by a user with the input device via a first control element displayed within the web browser of the user interface for a first scan mode in the performance of said step (a) and the send data signal is input by a user with the input device via a second control element displayed within the web browser of the user interface in the performance of said step (m). (see 'Start Scanning' and 'release batch'; page 2, "Release", "The Quillix Web Client releases image batches to the server for final processing")

Claim 25 is rejected since claim 25 contains the same limitations as recited in claim 9.

Regarding claim 26, "Quillix" discloses a method as claimed in claim 9, further comprising the step of: f) transmitting the document data from the scanner to a server. (page 2, "Capture begins with the acquisition of images via the Quillix TWAIN

interface, which accepts input from low or high-volume scanners")

Claim 27 is rejected since claim 27 contains the same limitations as recited in claims 9, 11, and 20 in combination.

Claims 29-33 are rejected since these claims contain substantially the same limitations as recited in claims 3-7 respectively.

Claims 35 and 36 is also rejected since claim 35 recites substantially the same limitations as recited in claim 18 and 19 respectively.

Claims 37-40 are rejected since these claims contain substantially the same limitations as recited in claims 21-24 respectively.

Claims 41-49 are rejected since these claims contain substantially the same limitations as recited in claims 1-8 and 20 respectively.

Claim 50 is rejected since claim 50 contains substantially the same limitations as recited in claims 1 and 20 in combination.

Regarding claim 51, "Quillix" discloses a system as claimed in claim 50, wherein the network includes an internetwork. (page 1, "Quillix is the first distributed information capture system built for the Internet")

Regarding claim 52, "Quillix" discloses a system as claimed in claim 50, wherein the client device includes a personal computer. (page 2, "System Requirements: Quillix Web Client")

Regarding claim 53, "Quillix" discloses a system as claimed in claim 50, wherein the user interface includes a web browser in which the document data is displayed. (page 1, "Quillix runs within the Web browser...")

Claim 55 is rejected since claim 55 contains substantially the same limitations as recited in claims 1 and 20 in combination.

Claim 56 is rejected since claim 56 contains substantially the same limitation as recited in claim 51.

Claim 57 is rejected since claim 57 contains substantially the same limitations as recited in claims 1 and 20 in combination.

Claim 58 is rejected since claim 58 contains substantially the same limitations as recited in claim 11.

Claim 59 is rejected since claim 59 contains substantially the same limitations as recited in claim 20.

Regarding claim 60, "Quillix" discloses a method as claimed in claim 1 further comprising:

b) inputting index data identifying the document data into the index field portion. (see 'Batch Name' in figure; page 2,

"Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 61, "Quillix" discloses a method as claimed in claim 60 wherein the index data input in said step (b) comprises a document name identifying the scanned document. (see 'Batch Name' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 62, "Quillix" discloses a method as claimed in claim 60 wherein the index data input in said step (b) comprises an identification number identifying the scanned document. (see 'Batch Name' and 'PO237' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 64, "Quillix" discloses a method as claimed in claim 60 wherein the index data input in said step (b) comprises text explaining the nature of the scanned document. (see 'Batch Name' and 'PO237' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 65, "Quillix" discloses a method as claimed in claim 60 wherein the index data input in said step (b) identifies a matter to which the scanned document relates. (see 'Batch Name' and 'PO237' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 66, "Quillix" discloses a method as claimed in claim 60 wherein the index data input in said step (b) identifies a transaction to which the scanned document relates. (see 'Batch Name' and 'PO237' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 67, "Quillix" discloses a method as claimed in claim 60 further comprising the step of:

c) activating the control element by the user with the user interface to scan the document with a scanner to generate the document data. (see 'Start Scanning' in figure)

Regarding claim 68, "Quillix" discloses a method as claimed in claim 67 further comprising the step of:

d) activating the control element by the user to upload the document data representing the scanned document to a server over

a network. (see 'release batch' in figure; page 1, "Information entered into Quillix is processed by the Quillix server and then sent to the corporate system for further dispensation" and page 2, "The Quillix Web Client releases image batches to the server for final processing" and "Once released, the batched data is sent to the corporate information management system")

Regarding claim 69, "Quillix" discloses a method as claimed in claim 27 wherein the index data input in said step (j) identifies the scanned document. (see 'Batch Name' and 'PO237' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Claims 70 and 71 are also rejected since claim 70 recites substantially the same limitations as recited in claim 61 and 62 respectively.

Regarding claim 73, "Quillix" discloses a method as claimed in claim 27 wherein the index data input in said step (j) comprises text explaining the nature of the scanned document. (see 'Batch Name' and 'Summit3' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 74, "Quillix" discloses a method as claimed in claim 27 wherein the index data input in said step (j) identifies a matter to which the scanned document relates. (see 'Batch Name' and 'PO237' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Regarding claim 75, "Quillix" discloses a method as claimed in claim 27 wherein the index data input in said step (j) identifies a transaction to which the scanned document relates. (see 'Batch Name' and 'PO237' in figure; page 2, "Quillix includes a tool for the creating of new indexing forms" and "Configurable batch profiles define...the indexing form and fields used to index the batch")

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 23, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Quillix".

Regarding claim 2, "Quillix" discloses a method as claimed in claim 1.

"Quillix" does not expressly disclose wherein the control element is operable by the user with the input device to alternately generate the start scan signal and the send data signal with respective successive activations of the control element with the input device, however, "Quillix" does disclose wherein the start scan signal and the send data signal are generated by separate control elements (see 'Start Scanning' and 'release batch'; page 2, "Release", "The Quillix Web Client releases image batches to the server for final processing").

Examiner takes Official Notice (see MPEP § 2144.03) that a control element used to alternately generate the start scan signal and the send data signal with respective successive activations of the control element in a user interface was well known in the art at the time the invention was made as a user interface widget known as a "toggle button" and, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of "Quillix" to use the "toggle button" as known by those of ordinary skill in the art.

Claim 23 is also rejected since claim 23 recites substantially the same limitations as claim 2.

Regarding claim 63, "Quillix" discloses a method as claimed in claim 60.

"Quillix" does not expressly disclose wherein the index data input in said step (b) comprises a file path indicating the subdirectory on the server at which the scanned document is to be stored.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of inputting index data to identify the document data would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

(10) Response to Argument

The Applicant has argued that the statements made by the Applicant on the record do not constitute an admission of prior

art and therefore the "Quillix Data Sheet" does not qualify as prior art.

MPEP 2129 states:

"A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003).

In the opinion of the Examiner, the crux of the issue for appeal in this case is whether the Applicant's statements on the record regarding the work of another, namely the Quillix invention by Prevalent Software, Inc., is to be considered prior art against the claims and whether the Applicant's statement constitutes an admission that the work is prior art.

The Examiner submits that, in accordance with MPEP 2129, the statement made by the Applicant on the record during prosecution regarding an exhibit, namely Exhibit 21, on pages 60-62 of the response filed 7 May 2004 to the Non Final Rejection mailed 7 November 2003 that "Since Quillix contains similar or the same functionality as the claimed invention..." is an admission of prior art since the Applicant admitted on the

record that the Quillix invention, the work of another, contains similar or the same functionality of the claimed invention and, as shown by the Exhibit 21 submitted within the response filed 7 May 2004, the Applicant further admitted that the Quillix invention was in fact announced to the public on 18 January 2000, which is before the effective filing date of 3 February 2000 of the instant application. The Examiner also submitted further evidence, namely the press release "Prevalent Software Inc. Introduces Quillix" as noted within the Final Rejection mailed 17 November 2005, that corroborates the Applicant's admission that the Quillix invention was announced to the public on 18 January 2000 and describes, in some detail, the features and functionality of the Quillix invention which also appears to corroborate at least some of the features and functionality described within the "Quillix Data Sheet" reference which embodies the Quillix invention. Therefore, since the Applicant admitted that Quillix contains similar or the same functionality of the claimed invention and that the invention was made prior to the filing of the patent application as admitted by the Applicant and was further corroborated by evidence cited by the Examiner, the Examiner submits that the Quillix invention is available as prior art against the claims in accordance with MPEP 2129 and *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324

F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). Furthermore, since the Quillix invention is available as prior art, the "Quillix Data Sheet" reference, which substantially describes in detail the features and functionality of the Quillix invention and is used to reject the claimed invention, the Examiner submits that the "Quillix Data Sheet" reference is a valid reference used to reject the claimed invention based on the Applicant's admission and, therefore, the rejection of the claims using the "Quillix Data Sheet" reference should be sustained.

The Examiner notes that, as shown in the *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003) decision, any prior art admission by the Applicant is available as prior art against the claims regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. Throughout the Appeal Brief filed by the Applicant, the Applicant incorrectly states that the "Quillix Data Sheet" reference is prior art under 35 USC 102. Since the Applicant has admitted that Quillix is prior art in accordance with MPEP 2129 and the *Riverwood Int'l Corp. v. R.A. Jones & Co.* decision, the issue of whether the "Quillix Data Sheet" reference is valid under 35 USC 102 is irrelevant to the case at hand and the

Examiner submits that the Applicant's arguments regarding the applicability of 35 USC 102 of the "Quillix Data Sheet reference" are moot.

Since the Examiner has shown the features and functionality of the Quillix invention given the disclosures of the reference "Quillix Data Sheet" and their one-to-one correspondence with the claimed invention as shown and explained previously by the Examiner and the Applicant has readily admitted that the Quillix invention has the same or similar functionality of the claimed invention, the Examiner submits that the "Quillix Data Sheet" teaches the limitations of the rejected claims as shown above in section 9 and the rejection should be sustained.

The Applicant also argues the Examiner's refusal to consider the Applicant's submissions under 37 CFR 1.131 by saying that the Examiner "effectively refused to consider the Declaration of Alexandre Okonechnikov" and "The Examiner stated that the status of the Quillix data sheet as alleged admitted prior art made it unnecessary to further consider evidence of conception and reduction to practice" and that "Such refusal was improper".

MPEP 715 states:

"An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situations...(G) Where applicant

has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case, that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131. *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973); *In re Garfinkel*, 437 F.2d 1000, 168 USPQ 659 (CCPA 1971); *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964); *In re Lopresti*, 333 F.2d 932, 142 USPQ 177 (CCPA 1964)."

Since the Applicant has clearly admitted on the record that the Quillix invention is prior art and that the subject matter regarding the Quillix invention is embodied within the "Quillix Data Sheet" reference, the Examiner submits that the "Quillix Data Sheet" reference may not be overcome by an affidavit or declaration under 37 CFR 1.131 in accordance with MPEP 715. It is also noted that the Examiner did consider the submission as submitted on page 4 of the Final Rejection mailed 17 November 2005.

In regards to the Applicant's arguments that the Official Notice rejection of claims 2, 23, and 63 is improper, the Examiner submits that, since the Applicant has readily admitted that the Quillix invention contains similar or the same functionality and is therefore prior art, these arguments are moot. Nevertheless, the Examiner submits that a proper

obviousness rejection has been established since the Applicant admitted that this subject matter was well known and used in the art. In the Non Final Rejection mailed 13 October 2004, the Examiner rejected claims 2 and 23 by taking Official Notice that the use of a control element as claimed was a commonly known user interface widget known as a "toggle button". The Examiner gave the Applicant the opportunity to traverse the Examiner's taking of Official Notice as required by MPEP 2144.03. The Applicant did not demand that the Examiner present a reference when responding to the rejection in the response filed 21 July 2005. In fact, the Applicant did not traverse anything regarding the Official Notice. Therefore, since the Applicant failed to seasonably challenge the Examiner's assertions by explicitly demanding that the Examiner submit evidence, this limitation was considered to be admitted prior art for the course of prosecution and the claimed limitations are therefore admitted to be within the knowledge of one of ordinary skill in the art. It is also noted that the Examiner also provided for the record a reference, namely US Patent 6 266 623 to Vock et al, that shows such a control element. The Examiner submits that, in view of the teachings of the "Quillix Data Sheet" admitted by the Applicant and the admitted control element as claimed in claims 2 and 23, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to combine the teachings of "Quillix Data Sheet" and the control element based on the knowledge of one of ordinary skill in the art that the control element was used to alternately generate signals with successive activation of the control element by the user and would have reasonably expected the successful combination of the control element with the user interface as taught in the "Quillix Data Sheet" reference.

The Applicant also argues that the Official Notice as cited by the Examiner does not consider the claim "as a whole" and that the Examiner has failed to consider evidence of secondary factors establishing nonobviousness under 37 CFR 1.312. As shown above, the Applicant has readily admitted that the Quillix invention contains similar or the same functionality of the claimed invention and is therefore prior art, therefore rendering these arguments moot. The Examiner has also established a prima facie case of obviousness. Therefore, it is submitted that the rejection is valid and should be sustained. Further, the Examiner has considered this evidence of secondary factors as noted in the Non Final Rejection mailed 13 October 2004.

The Applicant also argues that claim 63 is not directed to non-functional descriptive language. The Examiner submits that,

since the Applicant has readily admitted that the Quillix invention contains similar or the same functionality of the claimed invention and is therefore prior art, these arguments are moot. Nevertheless, the Examiner submits that claim 63 is unpatentable since the claimed limitations contain non-functional descriptive language and therefore does not patentably distinguish the claimed invention from the Quillix invention. Claim 60, from which claim 63 depends, specifically recites that index data is used for "identifying the document data". Claim 63 then recites wherein the index data comprises "a file path indicating the subdirectory on the server at which the scanned document is to be stored". However, as claimed by the Applicant, the index data is data which identifies the document. A user may enter any such index data which identifies the document including a file path which indicates where the document may be stored. However, it is the position of the Examiner that, in view of the claimed limitations, that any such data may be entered as index data. Claim 63 does not explicitly recite that the file path is functionally involved in the steps recited, namely the step of inputting the index data by the user, therefore, the file path is considered by the Examiner to be nonfunctional descriptive material with respect to the step of entering index data which describes a document since the

method of entering the index data would be performed regardless of the index data and the user could enter any such data including a file path.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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